

**REMARKS/ARGUMENTS**

The Office Action mailed November 23, 2004, has been received and reviewed. Claims 1 through 115 are currently pending in the application. Claims 1 through 103, 107, 108 and 110 stand rejected. Claims 113 through 115 are allowed. Claims 104 through 106, 109 and 112 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicants have amended claims 1, 6, 26, 56, 64, 83 and 113 and respectfully request reconsideration of the application as amended herein.

Applicants have amended claims 1, 64 and 83 to address the rejection under 35 U.S.C. 122, 2<sup>nd</sup> paragraph, which amendment broadens each of the claims while more clearly defining the invention. Each of claims 1, 64 and 83 has also been amended to recite the presence of “at least one” blade-biasing element.”

Claim 1 has also been amended to more clearly structurally define over the Dewey reference in terms of the orientation and positioning of the at least one blade-biasing element and to clarify the operating mechanism of the at least one laterally movable blade.

Claim 6 has been amended merely to clarify that the longitudinal drilling fluid flow path is enlargeable.

Claim 26 has been amended to recite a blade spacer element in lateral contact with the at least one laterally movable blade.

Claim 56 has been amended to recite an operable mechanism for inhibiting fluid flow through the claimed port.

Claim 113 has been amended solely to correct an inadvertent typographical error.

No new matter has been added.

### **Claim Objections**

Claim 113 was objected to by the Examiner because of writing formalities. Claim 113 has been amended herein, as required by the Examiner. Applicants regret the typographical error.

### **35 U.S.C. § 112 Claim Rejections**

Claims 1 through 100 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicant notes that the Examiner has objected to the language in independent claims 1, 64 and 83 of “a structure for retaining the at least one laterally moveable blade at an outermost lateral position” as having no support in the specification or drawings. Applicants respectfully note (by way of example only) in FIGS. 1A, 1B, 1D1 and 1D2 “retention elements” 16 and 20 and moveable blades 12 and 14. See also paragraphs [0069] through [0077]. Biasing elements 24 and 26 are disposed between blade 12 and retention element 16, and blade 12 is forced outwardly by fluid pressure against retention element 16. The same structure is mirrored with blade 14 being forced outwardly by fluid pressure against retention element 20 when the bias of biasing elements 28 and 30. Thus, retention elements 16 and 20 “retain” blades 12 and 14 at an outermost lateral position.

However, to more precisely, and broadly define the structure in question and to avoid any implication that the retention elements of the present invention somehow “lock” the blades in place at an outermost lateral position, Applicants have amended each of claims 1, 64 and 83 to recite “structure for preventing lateral movement of the at least one laterally movable blade beyond an outermost lateral position corresponding to an expanded diameter of the expandable reamer.”

Reconsideration and withdrawal of the rejection of claims 1 through 100 is respectfully requested.

### 35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 6,732,817 (formerly U.S. Patent Application Publication No. 2003/0155155 A1) to Dewey et al.

Claims 1 through 4, 6 through 8, 21 through 24, 26 through 29, 54, 56, 60 through 63, 101 through 103, 107, 108, and 110 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dewey et al. (now U.S. Patent No. 6,732,817). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants have amended claim 1, in pertinent part, to further define over Dewey et al. (“Dewey”). Applicants have amended claim 1 to recite “. . . at least one blade-biasing element oriented substantially transversely to the longitudinal axis and in contact with the at least one laterally movable blade for holding the at least one laterally movable blade at an innermost lateral position with a force, the innermost lateral position corresponding to no more than an initial diameter of the expandable reamer . . .” Applicants note that biasing spring 540 of Dewey is parallel to the longitudinal axis in both embodiments, and that biasing spring is not in contact with any of blades 520 in either embodiment. Applicants further note that claim 1 as amended requires that the actuation sleeve is configured to selectively prevent or allow drilling fluid communication with the at least one laterally movable blade to effect outward lateral movement thereof. Dewey never communicates drilling fluid with any blade, but only with drive ring 570, which acts upon the blade. Accordingly, the invention as presently claimed in amended claim 1 is not described, either expressly or inherently, by Dewey. Withdrawal of the rejection is respectfully requested.

Claims 2-4, 6-8, 21-42, 26-29, 54, 56 and 60-63 are allowable as depending from claim 1.

Claim 2 is further allowable as nozzles 575 extends through drive ring 570, which is not, in fact, attached to any of blades 520 but which acts (presses) on blades 520 to move them upwardly and outwardly. Therefore, nozzles 575 cannot be said to be “disposed within” any

blade. Further, from Col. 9, lines 54-61 of Dewey, it is apparent that nozzles 575 are rotationally (circumferentially) offset from blades 520 as the fluid emanating from nozzles 575 is said to clean and cool cutting structures 700 disposed on surface 526 of a blade 520.

Claim 6, as amended, is further allowable as Dewey fails to describe a structure for increasing a size of the drilling fluid flow path longitudinally through the expandable reamer as in the present invention. (See FIG. 1I of the present application and accompanying text).

Claim 24 is further allowable as the adjustable drive ring 550 of Dewey acts on all of the blades 520, and not selectively on some. Accordingly, the adjustment in blade protrusion using drive ring 550 would be uniform among all blades 520.

Claim 26 as amended is allowable as Dewey fails to describe a blade spacer element in lateral contact with any blade.

Claim 56 as amended is allowable as Dewey fails to describe structure for inhibiting drilling fluid flow through a port responsive to lateral outward movement of any blade.

Claim 101 is allowable as Dewey fails to describe operation of a tool wherein drilling fluid is allowed to communicate with at least one laterally movable blade and the blade is moved to an outermost lateral position by way of such communication. Drilling fluid in Dewey acts on drive ring 570, which moves longitudinally to move blades 520 upwardly and outwardly, and does not act on blades 520 themselves.

Claims 102, 103, 107, 108 and 110 are allowable as depending from claim 101.

### **35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on U.S. Patent No. 6,732,817 (formerly U.S. Patent Application Publication No. 2003/0155155 A1) to Dewey et al.

Claims 5, 30 through 35, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dewey et al. (U.S. Patent No. 6,732,817). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must

be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Claims 5, 11 and 31-35 are allowable as depending from claim 1. Further, Applicants do not understand the rejection of claim 11, as there is no recitation of using the present invention in casing. If the rejection is of claim 111, the claim is allowable as depending from claim 101.

As to claim 32, Dewey fails to teach any arrangement wherein blades 520 fail to longitudinally overlap, as claimed. In other words, Applicants claim an arrangement wherein a blade is disposed on the reamer longitudinally wholly above another blade.

As to claim 33, Dewey appears to only teach disposition of blades 520 circumferentially symmetrically (at 120° circumferential intervals about the tool) and not asymmetrically (see, for example, Applicants' FIG. 5B) as claimed.

Obviousness Rejection Based on U.S. Patent No. 6,732,817 (formerly U.S. Patent Application Publication No. 2003/0155155 A1) to Dewey et al. in View of U.S. Patent No. 5,447,207 to Jones

Claims 58 and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dewey et al. (U.S. Patent No. 6,732,817) in view of Jones (U.S. Patent No. 5,447,207). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 58 and 59 are allowable as depending from claim 1. Further, Applicants note that claim 58 requires the lock rods to extend longitudinally, whereas "lock rods" 44 of Jones extend laterally, or transverse to the longitudinal axis of the tool. As to claim 59, it is also apparent that the Jones lock rods 44 do not extend through a spacer element but only through a blade 18 and the tool housing.

Reconsideration and withdrawal of the rejection is respectfully solicited.

**Allowable Subject Matter**

Claims 104 through 106, 109 and 112 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicants respectfully assert that these claims are allowable in their present form.

Claims 64 through 100 are indicated as allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as set forth in the Office Action. Applicants have amended claim 64 to overcome this rejection and respectfully request withdrawal thereof.

Claims 9 through 20, 25, 36 through 53, 55 and 57 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as set forth in the Office Action, including all of the limitations of the base claim and any intervening claims. Applicants respectfully asserts that these claims are allowable in their present form.

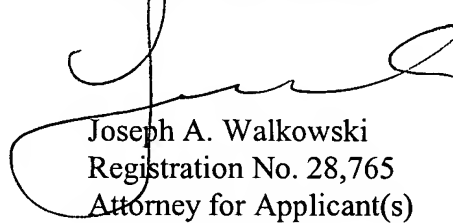
**ENTRY OF AMENDMENTS**

The amendments to claims 1, 6, 26, 56, 64, 83 and 113 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

**CONCLUSION**

Claims 1 through 115 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Joe Walkowski', is written over the printed name and title.

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